

REMARKS**I. General**

The present Office Action raises the following issues:

- Claim 1 stands rejected under 35 U.S.C. 102(b) as anticipated by Brook, U.S. Pat. No. 5,673,105 (hereinafter *Brook*); and
- Claims 2-21 are objected to as being dependent upon a rejected base claim.

Applicant requests reconsideration and withdrawal of the outstanding rejections in light of the amendments and remarks contained herein. Claims 1-21 remain pending in this application.

II. Allowable subject matter

As noted, the Office Action objects to claims 2-21 as being dependent upon a rejected base claim. However, Applicant respectfully points out that claims 12 and 18 are independent claims and that claims 13-17 and 19-21, depend from claims 12 and 18, respectively. Therefore, Applicant assumes that the Examiner intended to indicate that claims 12-21 are allowed and that only claims 2-11 are objected to as being dependent upon a rejected base claim, claim 1. If this is not the case, Applicant respectfully requests clarification in a non-final Office Action so that Applicant will have a full and fair opportunity to address any rejections.

Allowable claims 2 and 9 are amended above to place them in independent form. Therefore, independent claims 2 and 9, as amended are patentable. Claims 3-8, ultimately depend from now independent claim 2, and thereby inherit all limitations of claim 2, as amended. Therefore, each of claims 3-8 are also patentable.

II. Rejection under 35 U.S.C. § 102(b)

As noted above, claim 1 stands rejected under 35 U.S.C. § 102(b) as anticipated by *Brook*. In response, Applicant has amended claim 1 to clarify that the flap portion is “adapted to open to enable insertion of said media onto said platen, between said base portion

and said platen, while said base portion is in said closed position” (emphasis added). Basis for this element exists in the claims themselves, as originally filed. Therefore, no new matter is added by the amendment. Additionally claim 1 has been amended to correct a typographical error, replacing the occurrence of the word “lest” with the word “least” in the sixth line of claim 1.

It is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Applicant respectfully asserts that the cited *Brook* reference does not satisfy these requirements with respect to claim 1, as amended. *Brook* clearly shows in FIGURES 4 and 5 that item 12 to be scanned is inserted only under the cover panels alleged by the Office Action as teaching a flap (34A and 34D of FIGURE 4, or 34A and 34B of FIGURE 5). *Brook* does not teach, or suggest, inserting the item to be scanned between the cover panels alleged by the Office Action as teaching a base portion and the platen 18 (34B and 34C of FIGURE 4, or 34C and 34D of FIGURE 5), while the alleged base portion is in a closed position.

Therefore, Applicant respectfully asserts that at least for this reason independent claim 1, as amended, is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between claim 1 and the prior art of record, and a person of ordinary skill in the art considering the prior art would not find these differences obvious.

Claims 10 and 11 depend directly from independent claim 1, and thus each of claims 10 and 11 inherit all limitations of claim 1, as amended. Therefore, for at least the reasons advanced above in addressing the anticipation rejection of claim 1, each of claims 10 and 11

sets forth features and limitations not recited by *Brook*. Thus, Applicant respectfully asserts that claims 10 and 11 are also patentable.

III. Conclusion

For at least the reasons given above, Applicant submits that the pending claims distinguish over the prior art under 35 U.S.C. § 102 and that this application is in full condition for allowance.

Fees due with this Amendment are dealt with in the accompanying fee transmittals and Applicant believes no further fees are due with this Amendment. However, if additional fees are due, please charge Deposit Account No. 08-2025, under Order No. 10010564-1, from which the undersigned is authorized to draw.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can helpful in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482737467US, in an envelope addressed to: MS Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: March 29, 2005

Typed Name: Susan Bloomfield

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Respectfully submitted,

By *[Signature]*

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